

REMARKS

In the Office Action,¹ the Examiner:

rejected claims 1-42 under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 6,463,421 to Junger ("Junger"); and

rejected claim 43 under 35 U.S.C. § 103(a) as unpatentable over Junger in view of U.S. Publication No. 2001/0032143 to Haseltine ("Haseltine").

Claims 1-4, 7-12, 17-21, 24-31, 33-36, and 40-43 are amended. Claim 44 is newly added by this Amendment. Claims 1-44 are pending.

Applicant respectfully traverses the rejection of claims 1-42 under 35 U.S.C. §102(b) as anticipated by Junger.

In order to properly establish that Junger anticipates Applicant's claimed invention under 35 U.S.C. § 102(b), each and every element of each of the claims in issue must be found, either expressly described or under principles of inherency, in a single reference. Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." See M.P.E.P. § 2131, quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989) (emphasis added).

New independent claim 44 recites a "warehouse management system" and a "customer relationship management system." Each of these management systems is tasked with unique responsibilities as recited in claim 44. For example, claim 44 recites

¹ The Office Action contains a number of statement reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement of characterization in the Office Action.

that a “disposition decision” is captured in the “warehouse management system.” This “disposition decision” is communicated to the “customer relationship management system.” The “customer relationship management system” then triggers a process to be executed. While claim 44 has not been rejected, Applicant asserts that in order to properly anticipate claim 44, the Office Action must not only show two different management systems in Junger, the Office Action must show that each of the responsibilities of each management system are performed in the manner claimed. But, Junger does not teach, or even suggest, management systems that perform in the manner claimed in claim 44.

The Office Action seems to confuse exactly which management system in Junger supposedly performs which elements of claim 1, which in many respects is similar to claim 44. For example, in rejecting claim 1, the Office Action suggests that the second management system is the “manual review” process disclosed by Junger in column 8, lines 17-32. Office Action at page 2. In rejecting claims 2 and 3, however, the Office Action suggests that Junger’s manufacturer computer system corresponds to the “first management system” and the “regional product return center” is construed as the second management system. Office Action at page 3.

Clearly then, the rejection of at least claim 3 is improper because the Office Action has not shown how the feature “communicating the captured disposition decision from the first management system to a second management system” is disclosed in Junger because the Office Action switches between alleged second management systems. The Office Action, therefore, has not shown, and cannot show, that Junger

discloses that the “disposition decision” is communicated between the “manufacturer computer system” and the “regional product return center” as recited in dependent claim 3 (incorporating the elements of independent claim 1 from which claim 3 depends). Thus, the rejection of at least claim 3 should be withdrawn.

Notwithstanding the above discussion, Applicant asserts that Junger does not disclose each and every feature of claim 1. For example, Junger does not disclose or suggest “communicating the captured disposition decision from the computer based first management system to a computer based second management system; and triggering, in response to the captured disposition decision, at least one process in the computer based second management system” recited in claim 1.

The Office Action states that Junger discloses the claimed “first management system,” in the abstract, as the “manufacturer computer system.” Office Action at page 3. The Office Action also states that Junger discloses the claimed “second management system,” in the abstract, as a “regional product return center.” Office Action at page 3. Applicant asserts that any interpretation of claim 1 that includes a human based management system is rendered moot by the amendment of claim 1. Thus, a “manual review” cannot be construed as a “second management system” as the Office Action suggests. Office Action at page 2. These statements by the Office Action, however, are directly contradicted by Junger.

Junger states that “[a] computer system at a regional product return center scans a returned product for identifying information, access a manufacturer return approval computer system through the internet or the like, and then submits the identifying information to the manufacture [sic] for return approval. The manufacturer computer

system utilizes the identifying information to access an electronic registration database to determine whether the returned product satisfies applicable return criteria. If so, the product is approved for return to the manufacturer. . . . In response to the product identifying information submitted by the regional product return center, the manufacturing provides a list of approved returns and unapproved returns along with a return authorization number for the batch of approved returns.” Junger Abstract.

In the disclosure, Junger states “ “[a]fter the returned products arrive at the regional warehouse 1, they are sorted by manufacturer and/or product, and are shipped from the regional warehouse 1 to the manufacturer warehouse 5 for credit or replacement. The manufacturer then inspects the returned products to ensure that they comply with necessary return conditions and, if appropriate, issues a credit or replacement product” (emphasis added). Junger col. 3, line 66 -col. 4, line 5.

Thus, with respect to the recitation of “communicating the captured disposition decision from the computer based first management system to a computer based second management system” in claim 1, Junger does not disclose or suggest at least this element.

Assuming, as the Office Action suggests, that the “warehouse computer system” disclosed by Junger can constitute the “first management system,” which Applicant does not concede, there is no disclosure in Junger that the captured “disposition decision” is communicated to the “regional product return center,” which the Office Action suggests constitutes the “second management system,” which Applicant also does not concede. Junger, as cited above, plainly discloses that it is the manufacturer that inspects returned products. If we can assume, *arguendo*, that a disposition

decision is actually captured and put into the manufacturer computer system, Junger has no reason to communicate the disposition decision to the “product return center.” The “product return center” is only where products are returned, and has nothing to do with determining a disposition decision. Consistent with the disclosure of Junger, the “product return center’s” only responsibility is to determine whether or not to ship an item to the manufacturer because shipping fewer products saves shipping costs.

Applicant further notes that determining whether or not to ship a product cannot constitute a “disposition decision” as defined in the Applicant’s specification. A shipping determination cannot constitute a “disposition decision” as the term is defined in the specification. Similarly, scanning an object in Junger, as disclosed, for its “product identifying information” cannot constitute the claimed “disposition decision” because the identifying number has nothing whatsoever to do with the “disposition” of the product.

There is no disclosure in Junger of “communicating the captured disposition decision from the computer based first management system to a computer based second management system.” Not only is such a disclosure not explicit from Junger, there is also no reason for Junger to communicate the results of the inspection to the “product return center.” As such, Junger does not disclose, or even suggest, this feature of claim 1 and the rejection should be withdrawn.

With respect to respect to the recitation of “triggering, in response to the captured disposition decision, at least one process in the computer based second management system” in claim 1, Junger also does not disclose or suggest this element of claim 1.

If not solely because Junger does not disclose that the alleged “second management system” even receives a “disposition decision,” the rejection of claim 1 is

improper because in Junger no “disposition decision” triggers a “process in the . . . second management system.”

The Office Action suggests that “issuing a credit or replacement” is the “process” triggered by the “disposition decision” in the alleged “second management system.” Office Action at page 3. But, this suggestion is not correct.

Junger plainly discloses that “[t]he **manufacturer inspects the returned products**” which the Office Action has already interpreted as the “first management system.” Junger col. 4, lines 2-3. Thus, according to this interpretation, it is what the Office Action has construed to the “first management system” that is issuing credit or replacement and not the “second management system” as claimed in claim 1. Thus, it is not correct to say that “issuing a credit or replacement” is a process accomplished by what is alleged to be the “second management system” in Junger.

For similar reasons, determining whether or not to ship a product in Junger cannot constitute a “process” in the claimed “second management system” because a shipping determination cannot logically be based on a “disposition decision.” In other words, a “second management system” cannot begin a return process based on instructions from a “first management system” **before** the “second management system” has transmitted information needed by the “first management system” in order to make a “disposition decision.” Therefore, Junger does not disclose, or even suggest, “triggering, in response to the captured disposition decision, at least one process in the computer based second management system” as recited in claim 1. Because Junger does not expressly or inherently disclose each and every element of claim 1, the rejection of claim 1 is improper and should be withdrawn.

For at least the above reasons, independent claim 1 is not anticipated by Junger. Claims 2-7 are allowable for at least the reason that they depend from allowable claim 1. Independent claims 8, 12, 18, 25, 29, and 34, although of a different scope, include recitations similar to those discussed above in relation to independent claim 1 and are not anticipated by Junger for reasons at least similar to those discussed with respect to claim 1. Claims 9-11, 13-17, 19-24, 26-28, 30-33, and 35-43 are allowable for at least the reason that they depend from one of allowable claims 8, 12, 18, 25, 29, and 34 respectively. Therefore, the Examiner should withdraw the rejection of claims 1-42 under 35 U.S.C. § 102(b).

Claim 43 depends from allowable claim 34 and therefore incorporates every element of claim 34. Since claim 34 is allowable, claim 43 is allowable for at least the same reasons as claim 34 inasmuch as Haseltine does not remedy the above discussed deficiencies of independent claim 34. Accordingly, a *prima facie* case of obviousness has not been established with respect to claim 43, and the rejection under 35 U.S.C. § 103(a) must be withdrawn.

CONCLUSION


In view of the foregoing, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: December 18, 2008

By: 
Travis R. Banta
Reg. No. 60,498
Telephone: 202-408-4000